REMARKS

Claims 1-27, 29-54, 57-59, 63-65, 110-113 and 118-121 are pending in the present application.

Procedural History

Applicants note that the 35 U.S.C. §103(a) rejection over Unger in view of Slezak discussed below and at pages 2-11 of the present Office Action, merely restates the same rejection made in Examiner's Final Office Action mailed September 25, 2007 ("Final Office Action") and the Examiner's Non-Final Office Action dated February 26, 2007 ("Non-Final Office Action"). In response to the Final Office Action, Applicants filed a Notice of Appeal and a Request for Pre-Appeal Brief Conference with a Statement in support, dated December 17, 2007. In a decision dated January 28, 2008, the Pre-Appeal Brief Panel withdrew the rejection and reopened prosecution of the pending claims. Subsequently, a new non-final Office Action rejecting only claims 65-67 under 35 U.S.C. §102(e) was mailed on April 3, 2008. All other claims (1-27, 29-34, 36-54, 57-59, 63, 64, 110-113 and 118-121) were allowed. As such, Applicants are confused why the present Office Action includes a rejection of the claims over Unger in view of Slezak, and hereby restate the arguments with respect to such rejection.

Claim Rejection – 35 USC §103

1.   The Examiner has rejected claims 1-2,20-27, 29-34, 36-54, 59, 63-65, 110-113 and 118-121 under 35 U.S.C. §103(a) as being obvious over U.S. Patent No. 6,909,837 to Unger ("Unger") in view of U.S. Patent No. 6,006,257 to Slezak ("Slezak").

As a preliminary matter, the Examiner has included independent claim 33 in the rejection; however, no grounds for the rejection over Unger in view of Slezak have been provided in the Office Action. Thus, Applicants respectfully request the rejection of claim 33 be withdrawn or proper grounds for rejection be provided. Moreover, Applicants respectfully submit that there is nothing in the prior art of record that teaches making a determination if "the alternative advertisement can be displayed within a time

period needed to trick play through the remaining portion of the recorded advertisement," as recited in independent claim 33. Neither Unger, Slezak, nor the combination thereof teaches or suggests determining the time period needed to trick play through the recorded advertisement and whether the alternative advertisement can be displayed during that period. Therefore, independent claim 33 is patentable over the proposed combination of Unger and Slezak.

The Examiner contends that Unger discloses a method for displaying an alternative advertisement during a trick-play event, but acknowledges that Unger does not teach or suggest "a control means for ignoring the termination of trick play event mode during the recorded advertisement portion being viewed." The Examiner further contends that Slezak teaches the features that Unger lacks, and concludes that it would have been obvious to combine the teachings of Slezak with Unger. Applicants respectfully traverse this rejection.

The Examiner contends that the proposed combination results in "Unger with a control means as taught by Slezak for detecting an end of a trick play event during playing the recorded advertisement and continuing the trick play of the recorded advertisement until the end of the recorded advertisement thereby enhancing the capacity of the apparatus of Unger in order to force a viewer to view a certain portion of the program." (See October 26, 2009 Non-Final Office Action, page 3). However, independent claim 1 does not recite displaying a "program", but instead recites displaying "the alternative advertisement." Therefore, even if the combination teaches what the Examiner argues, the combination still fails to teach all aspects of claim 1.

Furthermore, Applicants disagree that the combination of Unger and Slezak would yield the result stated by the Examiner. The combination of Unger and Slezak does not teach or suggest, "continuing, until the end of the recorded advertisement, trick playing the recorded advertisement and displaying the alternative advertisement," as recited in independent claim 1. In Unger the advertisers desire the user to view the entire advertisement and not trick play through the ad. Although the advertiser in Unger desires to present the entire commercial message to the viewer, the advertiser is willing to settle

for the viewer receiving an abbreviated commercial message (see Unger, column 6, lines 47-53). In Unger, if the viewer stops the trick play, the viewer is returned to normal play of the underlying ad (see Unger, column 5, lines 48-50). Since the advertiser desires that the user view the underlying advertisement in its entirety, continuing to trick play the alternative advertisement after the user indicates that he desires to resume regular playback during an advertisement is counter-intuitive and non-obvious to the teachings of Unger, and contrary to what is recited in claim 1.

Similar to Unger, Slezak's system endeavors to have the user watch an entire commercial message. The point of Slezak's invention is getting a viewer to view an entire advertisement without skipping or fast forwarding. For example, Slezak states:

> If the viewer is viewing a "must view" video, the process proceeds
> to step 2022 where it is determined whether the command requests
> a forward shift in the current video stream or an entirely new video
> stream. If command does request a forward shift or change from
> the current video stream, the process is waited until the current
> "must view" video stream is completed in step 2024.   (Slezak,
> column 9, lines 50-56)

Therefore, Slezak does not support the notion of "continuing, until the end of the recorded advertisement, trick playing the recorded advertisement and displaying the alternative advertisement." Slezak instead endeavors to prevent fast-forward operations. Ultimately, neither Unger nor Slezak address the desirability of continuing to trick play the recorded advertisement.

In the above quoted section, when Slezak teaches that the "process is waited," it is not a trick play process that is being "waited." Slezak instead detects an initiation of a fast forward command or a channel change, not "an end of the trick play event." Therefore, Slezak cannot be said to teach "detecting an end of the trick play event prior to the end of the recorded advertisement;" and "continuing, until the end of the recorded advertisement, trick playing the recorded advertisement and displaying the alternative advertisement;" as recited in claim 1.

Additionally, Slezak teaches waiting for the "must view" video to play. In Slezak, the video that the user is viewing is completed, whereas, in claim 1, it is the video that the user is <u>not</u> viewing (i.e. the trick playing recorded advertisement) that affects the acknowledgement of trick play commands. In other words, Slezak waits until the end of the "must view" video. In contrast, claim 1, continues "until the end of the recorded advertisement, trick playing the recorded advertisement and displaying the alternative advertisement..."

Furthermore, Slezak does not teach "displaying the alternative advertisement" while continuing to trick play. Instead, Slezak teaches that "the process is waited until the current "must view" video stream is completed..." This is not for a trick play event, nor is it in response to the ending of a trick play event. Further, this is not an alternative video (derived from the underlying recorded advertisement) that is being played, but instead the "must view" video that is part of the original presentation stream.

Although the Examiner states that Unger only "fails to teach a control means for ignoring the termination of trick play event mode during the recorded advertisement portion being viewed," Unger also <u>fails to teach continuing to display the alternative advertisement as recited in claim 1</u>. Therefore, the combination of Unger and Slezak fails to teach all aspects of independent claim 1.

Independent claim 36 recites, "pausing the trick play event until said displaying alternative advertisement is complete if additional time is required to display entire alternative advertisement based on the point in advertisement that the trick play event occurs." Independent claim 63 recites, "means for automatically controlling the fast forward event, wherein if said means for detecting detects the end of the fast forward event prior to end of the recorded advertisement, said means for automatically controlling will continue to fast forward the recorded advertisement until the end of the recorded advertisement, and said means for displaying will continue to display the alternative advertisement until the end of the recorded advertisement."

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Furthermore, the Examiner argues, "Slezak teaches continuing to the end of the advertisement by ignoring an input of termination of playing the advertisement to force the viewer to view the advertisement until the end of the advertisement and Unger teach displaying alternative advertisement during trick play of the recorded advertisement. Since both Unger and Slezak teach forcing a viewer to view recorded advertisement it would have been obvious to one of ordinary skill in the art to combine Unger and Slezak to use the teaching ignoring a termination of playing an advertisement input by a viewer..." October 26, 2009 Non-Final Office Action. In response, Applicants point out that first, the presently claimed system does not ignore the user's input, instead, it registers the command and returns to the programming as soon as the trick-played advertisement ends. This is substantially different from Slezak, which completely ignores the user's command. Second, Slezak teaches completely ignoring a user's input to force the user to watch the "must-view video" until the end. There is no reason to believe that this teaching can be applied to trick-played advertisements such as those in Unger. Thus, there is no motivation to combine Slezak and Unger in the way suggested by the Examiner.

For similar reasons as discussed in relation to claim 1, independent claims 33, 34, 36, 63-65 are patentable over the combination of Unger and Slezak. Dependent claims 2, 20-27, 29-32, 37-54, 59, 110-113 and 118-121 are allowable based at least on their dependency on claims 1, 34, 36, and 63, respectively.

The Examiner has rejected claims 3, 4, 7-14, 17-19 and 57-58 as being unpatentable over Unger and Slezak, in further view of U.S. Patent No. 4,845,564 to Hakamada ("Hakamada"). For the same reasons discussed above, the combination of Unger and Slezak does not teach or suggest all features of independent claims 1 and 63. Hakamada does not teach or suggest these missing elements. Accordingly, independent claims 1 and 63 are allowable over Unger in view of Slezak and further in view of Hakamada. Therefore, dependent claims 3, 4, 7-14, 17-19 are allowable at least by their dependency on claim 1. Claims 57 and 58 are also allowable at least by their dependency on claim 63.

The Examiner has rejected claims 5, 6, 15 and 16 as being unpatentable over Unger, Slezak and Hakamada, in further view of U.S. Patent No. 5,031,044 to Canfield ("Canfield"). Applicants note that the Examiner's rejection on page 11 omits Slezak, but believe this to be a typographical error. For the same reasons discussed above, the combination of Unger, Slezak and Hakamada does not teach or suggest all features of independent claim 1. Canfield does not teach or suggest these missing elements. Accordingly, independent claim 1 is allowable over Unger in view of Slezak and Hakamada and in further view of Canfield. Therefore, dependent claims 5, 6, 15 and 16 are allowable at least by their dependency on claim 1.

2.   The Examiner has rejected claims 1-2, 20-27, 29-34, 36-54, 59, 63-65, 110-113 and 118-121 under 35 U.S.C. §103(a) as being obvious over Unger in view of U.S. Patent Application Publication No. 2002/0191950 to Wang ("Wang").

As previously discussed, in Unger the advertisers desire the user to view the entire advertisement and not trick play through the ad. Although the advertiser in Unger desires to present the entire commercial message to the viewer, the advertiser is willing to settle for the viewer receiving an abbreviated commercial message (see Unger, column 6, lines 47-53). In Unger, if the viewer stops the trick play, the viewer is returned to normal play of the underlying ad (see Unger, column 5, lines 48-50).

Wang teaches preventing "manual and/or automated skipping of television commercials when a recorded television video or video signal is playing on a video recording and playback device." Paragraph 22. In Wang, [t]he skipping control device sends control signals through the bus to the video recording and playback device for disabling or enabling one, a plurality of, or all of the manual and automated skipping functions of the video recording and playback device." Paragraph 26. Further, if the system of Wang determines "that the content classification signal indicates that the current portion of the video signal has commercial content then the device, in one embodiment, disables all manual and automated skipping functions of the video recording and playback device." Paragraph 28.

Applicants respectfully submit that the combination of Unger and Wang would be inoperable. Unger allows presenting an alternative advertisement to a user during a trick-play event; however, Unger allows stopping the alternative advertisement to return to the original advertisement. Wang, on the other hand, completely *prevents* the skipping of ads by disabling commands such as fast-forward. MPEP § 2143.01(V) states "[i]f proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is **no suggestion or motivation** to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)" (emphasis added). "If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are **not sufficient** to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)" (emphasis added). Thus, there is no motivation to combine Unger and Wang in the way proposed by the Examiner because doing so would result in a system that is unsatisfactory for the intended purpose of presenting trick-play ads as described in Unger. As such, the proposed combination of Unger and Wang is improper.

Moreover, unlike the proposed combination of Unger and Wang, the presently claimed subject matter does not in any way "enable or disable" the skipping functions of the video recording and playback device. Instead, when the presently claimed system receives a command to stop a trick-play, it registers the command but completes playing the alternate advertisement. Once the trick-played advertisement is completed, the system automatically switches to the recorded content. That is, in the presently claimed system, the user is not required to press a button to complete the requested command after the advertisement has finished playing. Conversely in Wang, a user's button press on a remote would not be registered and the user would be required to press the same button again when the commercial is completed.

Further, Wang does not teach, "<u>continuing, until the end of the recorded advertisement, trick playing the recorded advertisement and displaying the alternative advertisement</u>," as recited in claim 1. Because Wang prevents all skipping of

advertisements, a trick-play could not be continued as claimed. Ultimately, neither Wang nor Unger teach or suggest continuing trick-playing alternate advertisements.

Thus because the combination of Unger and Wang does not teach each and every element of claim 1, independent claim 1 is allowable over the cited prior art. Independent claims 33, 34, 36 and 63-65 are allowable for reasons similar to those discussed with respect to claim 1. Dependent claims 2, 20-27, 29-32, 37-54, 59, 110-113 and 118-121 are allowable based at least on their dependency on claims 1, 34, 36, and 63, respectively.

The Examiner has rejected claims 3, 4, 7-14, 17-19 and 57-58 as being unpatentable over Unger and Wang, in further view of U.S. Patent No. 4,845,564 to Hakamada ("Hakamada"). For the same reasons discussed above, the combination of Unger and Wang does not teach or suggest all features of independent claims 1 and 63. Hakamada does not teach or suggest these missing elements. Accordingly, independent claims 1 and 63 are allowable over Unger in view of Wang and further in view of Hakamada. Therefore, dependent claims 3, 4, 7-14, 17-19 are allowable at least by their dependency on claim 1. Claims 57 and 58 are also allowable at least by their dependency on claim 63.

The Examiner has rejected claims 5, 6, 15 and 16 as being unpatentable over Unger, Wang and Hakamada, in further view of U.S. Patent No. 5,031,044 to Canfield ("Canfield"). Applicants note that the Examiner's rejection on page 11 omits Hakamada, but believe this to be a typographical error. For the same reasons discussed above, the combination of Unger, Wang and Hakamada does not teach or suggest all features of independent claim 1. Canfield does not teach or suggest these missing elements. Accordingly, independent claim 1 is allowable over Unger in view of Wang and Hakamada and in further view of Canfield. Therefore, dependent claims 5, 6, 15 and 16 are allowable at least by their dependency on claim 1.
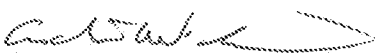
Conclusion

In view of the foregoing amendments and remarks, Applicants respectfully submit that the Examiner's objections and rejections have been overcome, and that the

application, including claims 1-27, 29-54, 63-65, 110-113 and 118-124, is in condition for allowance. Reconsideration and withdrawal of the Examiner's objections and rejections and an early Notice of Allowance are respectfully requested.

Respectfully submitted,

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